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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,175	03/26/2001	Stephen G. Perlman	04259P013X	2377

7590 11/09/2004
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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
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12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,175

Applicant(s)

PERLMAN ET AL.

Examiner

Shawn M. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 31-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to correspondence filed 9/21/04.

Information Disclosure Statement

The IDS filed 9/21/04 has crossed out references in the U.S. Patent Documents, because these documents were already previously cited by the IDS filed 4/23/04 and by the Examiner, respectively. The "Other Documents" that are crossed out are not publications.

Election/Restrictions

1. Newly submitted claims 31-60 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 31-60 (Group II) are related to claims 1-30 (Group I) as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I (claims 1-30) has separate utility such as displaying a potential list of words that may be selected by any of a variety of input devices (i.e. a mouse) and does not pertain to the specifics of the character-entry device. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I (claims 1-30) is not required for Group II (claims 31-60), restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,564,213 to Ortega et al. (hereinafter Ortega) and U.S. Publication No. 2003/0014753 to Beach et al. (hereinafter Beach).

Referring to claims 1, 11, and 21, Ortega discloses a method, system, and article of manufacture that detects a first word entered by a user with a character-entry device (col. 3, lines 12-19) and provides a potential list of second words to the user (i.e. Fig. 2B), the potential list of second words selected based, at least in part, on how frequently a string/phrase (multimedia program) whose name includes one of the second words has been selected, sold, etc. (i.e. based on popularity). See col. 4, lines 9-19 and 28-33 and col. 6, lines 26-36 and 63-67.

While the method of Ortega may clearly be used to search for all types of information, including multimedia, Ortega does not explicitly state that the method is for selecting a multimedia program within an entertainment system and that the first and second words are for a multimedia program. However, Beach teaches an input method for selecting words similar to that of Ortega, which is used for inputting and selecting television programs (multimedia programs), wherein a potential list of second words that may follow the first word are displayed. See Figs. 4 and 5 and page 2, paragraph 0021, for example. It would have been obvious to one

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of ordinary skill in the art to use the auto-completion/selection method of Ortega for selecting multimedia programs within an entertainment system as shown in Beach in order to quickly select/retrieve a desired program/show out of the many programs that are offered as supported in Beach.

Ortega teaches basing the potential list of words on popularity, as described above, and the number of times a program is played in the method/system of Ortega and Beach is a measure of popularity. Therefore, it would have been obvious to one of ordinary skill in the art to base, at least in part, the potential list of second words of Ortega and Beach on the frequency with which a multimedia program is played, because the most popular programs are the most likely to be selected as supported by Ortega.

Referring to claims 2, 12, and 22, Ortega discloses ordering the potential list of second words based at least in part, on the probability that each word in the potential list of second words will be selected by the user following the first word. See col. 1, lines 14-28 and 50-54 and col. 4, lines 9-14.

Referring to claims 3, 13, and 23, Ortega and Beach, *supra*, disclose detecting a second word of the multimedia program selected or entered by the user with a character-entry device and provide a potential list of third words of the multimedia program to the user, the potential list of third words selected based, at least in part, on how frequently a phrase (multimedia program) that includes one of the third words has been selected (played). Clearly, the user of Ortega and Beach may enter a new search word in the query field in Fig. 2B, which changes the list of suggested words. Furthermore, Ortega teaches that the query entry process is comprised of strings, which may be words or phrases (i.e. a first and second word), and then the auto

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completion suggests a word (i.e. third word) or phrase. See col. 1, line 65 - col. 2, line 20. Also, see col. 4, lines 9-19 and 28-33.

Referring to claims 4, 14, and 24, Ortega and Beach, *supra*, teach ordering the potential list of second words based, at least in part, on how frequently a phrase/string (multimedia program) whose name includes one of the second words has been selected (played). See col. 4, lines 9-19 and 28-33, which describe ordering the list based on popularity.

Referring to claims 5, 15, and 25, the second word of Ortega may be entered manually by the user (i.e. via the keyboard) using the character-entry device. See col. 2, lines 14-15. It may also be selected by the user from the potential list of second words. See col. 2, lines 36-40 and col. 5, lines 36-54.

Referring to claims 6, 16, and 26, Ortega teaches recording selection of the second word following the first word in a database. See col. 4, lines 1-52.

Referring to claims 7, 17, and 27, Ortega discloses linking the second word to the first word in the database. See col. 1, lines 25-27, which describes suggesting terms that frequently appear in combination, which requires tracking which words appear in what combination (i.e. the first and second word).

Referring to claims 8, 18, and 28, Ortega discloses storing the number of times that the user has selected the second word following the first word. See col. 4, lines 28-33, which describes monitoring the frequency (number of times) a query (completed selection of first and second word) is submitted, and that this may be customized for each user.

Referring to claims 9, 19, and 29, Ortega calculates a first probability that the second word will be selected by the user based, at least in part, on the number of times. See Fig. 5, 86,

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which shows that a score (probability) is assigned to the search terms (completed selection of first and second words in the query).

Referring to claims 10, 20, and 30, Ortega discloses calculating a second probability that the second word will be selected by the user by combining the first probability with a probability derived from how frequently a phrase (multimedia program) that includes one of the second words is included in the database, and selecting the potential list of words based, at least in part, on the second probability (score). See col. 6, lines 27-36.

Response to Arguments

3. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Ortega does not relate to selecting a multimedia program within an entertainment system. However, Ortega discloses searching for music titles (i.e. col. 4, line 60 – col. 5, line 4) along with various other types of information. Beach is directed at selecting multimedia programs within an entertainment system and uses an auto-completion method similar to that of Ortega. The combination of Ortega and Beach results in a system for selecting multimedia programs within an entertainment system in an efficient manner.

Applicant argues that Ortega does not consider how many times a multimedia program has been played and states that there are many ways to play a multimedia program other than through the use of a search query. It should be noted that no other way of playing a multimedia program is presented in the claims. Furthermore, the number of times a program is played is a factor in its popularity, and Ortega clearly teaches basing the list of words on popularity (i.e. col. 6, lines 33-34).

Applicant argues that Ortega does not teach combining two types of probability (based on user preference and incidence). However, col. 6, lines 26-36 describe giving each phrase (i.e. multimedia program) a score (probability) based on popularity (preference) and frequency of occurrence within the database (incidence).

Claims 31-60 are withdrawn from consideration; therefore, Applicant's arguments with respect to claims 31-60 are moot.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

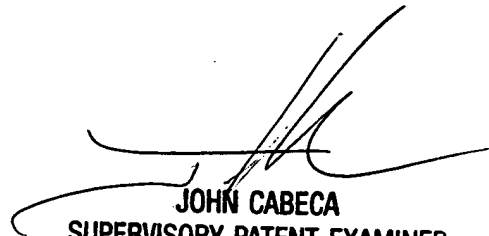
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is (703) 305-7756. The examiner can normally be reached on M-F 8:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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